

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Upon entry of the present amendment, claims 27-35 and 37-38 are pending. Claims 27-35 are withdrawn as directed to a non-elected invention. Claims 37-38 are under examination.

### **Request for Rejoinder**

Pursuant to M.P.E.P. § 821.04, Applicants respectfully request rejoinder of method claims 27-35. In accordance with M.P.E.P. § 821.04, Applicants amended claim 27 in the previously submitted response to correspond to the scope of claim 37.

### **Rejection under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 37 and 38 under 35 U.S.C. § 103(a) as allegedly rendered obvious over U.S. Patent No. 5,858,752 ("Seed") in view of Sasaki, *et al.*, *J Biol Chem* (1994)269:14730-14737 ("Sasaki"). This rejection is respectfully traversed because Seed is not prior art, and Sasaki does not disclose or suggest any murine Fuc-TVII enzyme. Applicants respectfully submit that it appears that the Examiner has misunderstood the data submitted in Exhibits A and B with the Rule 131 Declaration.

The Examiner alleges that Exhibit A does not provide sufficient evidence that the reduction to practice of the invention was prior to the effective date of Seed as a reference. *See*, page 2 of the present Official Action. The Examiner appears to have incorrectly understood that the evidence in Exhibit A disclosed Fuc-TIV enzyme but not Fuc-TVII enzyme. *See, Id.*

Applicants respectfully submit that this is an incorrect understanding of Exhibits A and B submitted with the Rule 131 Declaration accompanying the Response filed on March 20, 2007. First, Exhibit A demonstrates the design production of primers corresponding to the primers taught on page 47, lines 11-12 of the specification. As described in paragraph 4 of the Rule 131 Declaration primer 624B is identical to SEQ ID NO:3 (page 47, line 11). Primer 625B differs from SEQ ID NO:4 (page 47, line 12) at the three nucleotides between the BamHI

restriction endonuclease site and the stop codon. The primers of SEQ ID NO:4 and 625B will anneal to the identical coding nucleotide sequences of mouse Fuc-TVII. Therefore, Exhibit A clearly demonstrates that Applicants reduced to practice the primers set forth in claims 37-38 prior to the effective date of Seed as a reference.

Second, Applicants also reduced to practice the use of the primers shown in Exhibit A and on page 47 of the specification to amplify a nucleotide sequence encoding a Fuc-TVII enzyme prior to the effective date of Seed as a reference. This is shown in Exhibit B submitted with the Rule 131 Declaration. As explained in paragraph 6 of the Declaration, the stem and catalytic domains of Fuc-TVII enzyme sequence was amplified from “phage 104.” Cloning of the Fuc-TVII enzyme sequence was done in parallel with cloning of the stem and catalytic domains of Fuc-TIV and stem region of Fuc-TIV as controls. Exhibit B describes that the Fuc-TIV sequences were amplified using different primers. The Fuc-TIV stem and catalytic domains were amplified using primers 8966 and 623B. The Fuc-TIV stem domain was amplified using primers 8965 and 623B. The nucleic acid encoding the stem and catalytic domains of Fuc-TVII was amplified using primers 624B and 625B, as described in Exhibit A and taught on page 47. *See*, paragraph 2 on page 1 of Exhibit B. Exhibit B clearly demonstrates the reduction to practice of the amplification of a sequence encoding the stem and catalytic domains of mouse Fuc-TVII from a mouse nucleic acid sequence captured in a phage (*i.e.*, “phage 104”).

In accordance with M.P.E.P. § 715.02, Applicants have demonstrated possession of the basic inventive concept of what is claimed before the effective filing date of the Seed reference. In contradiction to the Examiner’s incorrect allegations regarding the data accompanying the Rule 131 Declaration, Exhibit B demonstrates using the primers as taught on page 47 of the specification and as claimed to amplify and clone a sequence encoding the stem and catalytic domains of mouse Fuc-TVII. Therefore, the Rule 131 Declaration is sufficient to overcome the rejection based on the Seed reference because Seed is not prior art.

Therefore, for the reasons set forth in the previous response and herein, Applicants respectfully maintain that the present invention is not obvious over Seed in view of Sasaki. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Appl. No. 10/700,505  
Amdt. dated June 20, 2007  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group 1651

PATENT

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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